

REMARKS**I. General**

Claims 1, 2, 4-6, 8, 10, 15, 17, 23, 28 and 29 are amended. Claims 1, 2, 5-6, 9-10, 13, 15 and 19-29 stand rejected under 35 U.S.C. § 102(e). Claims 3, 4, 7, 8, 11, 12, 17 and 18 stand rejected under 35 U.S.C. § 103(a). Applicant respectfully requests reconsideration in view of the following remarks:

II. The 35 U.S.C. § 102 Rejections

Claims 1, 2, 5-6, 9-10, 13, 15 and 19-29 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Number 5,742,905 to Pepe et al. (hereinafter “Pepe”). It is well established that to anticipate a claim under 35 U.S.C. § 102, a reference must teach every element of the claim, see M.P.E.P. § 2131. Applicant respectfully asserts that the disclosure of Pepe does not teach all elements of the claims.

Claims 1 and 5 require an agent adapted to compare the characteristics of email messages received for the subscriber, and to execute instructions received from the subscriber in response to the alert. Claim 9 requires prerecording on a mail server characteristics for messages to be routed, alerting the subscriber to the receipt of one or more messages for which a characteristic match is found and receiving instructions for forwarding the stored messages from the subscriber in response to the alert. Claim 13 requires a receiver adapted to receiving e-mail messages, a comparator adapted for comparing characteristics of received messages, an alert mechanism for alerting the subscriber, and save facility adapted for storing matched messages against future distribution instructions received from the subscriber in response to the alert.

Pepe describes a network that operates as an interface between various wireless and wireline networks. *See*, Abstract. Subscriber message receipt and delivery options are maintained in a database which may be accessed and updated by the subscriber. *See*, *id*. While Pepe does disclose forwarding email based on pre-defined instructions shown in a profile, Pepe does not disclose sending an alert in response to the receipt of an email message that matches characteristics, and executing instructions received from the subscriber in response to the alert.

In response to the Applicant's arguments in the Amendment dated December 22, 2004, the Examiner, in the Final Office Action, has cited to the portions of Pepe describing the "CallCommand" function as anticipating the limitations of Claims 1 and 5. Applicant would respectfully traverse the Examiner's characterization of Pepe's CallCommand function. Pepe clearly states that the CallCommand function "provides subscribers real-time control of voice calls" Column 29, lines 27-28. The CallCommand function can be used to screen an incoming call and to route the call to a number specified by the user. Column 29, lines 42-55. The CallCommand function only executes instructions received from the subscriber for voice calls, not email. See, Column 29, line 26 through Column 31, line 13, describing the CallCommand functionality.

The Examiner has cited to Column 30, lines 14-27 as teaching "the CallCommand service and its application to E-Mail. Applicant again respectfully disagrees with the Examiner's characterization of Pepe. Column 30, lines 14-17 states "Call command users pre-subscribe to a wireless data service such as Ardis or RAM mobile data for E-mail, call management, and other wireless data applications." The remainder of the cited portion does not describe e-mail. Applicant would respectfully point out that the cited portion of Pepe not only does not describe a MailAlert code set adapted to compare the characteristics of email messages received for the subscriber, and to execute instructions received from the subscriber in response to the alert, Pepe teaches away from this functionality with respect to email as Pepe's CallCommand subscribers pre-subscribe to a wireless data service to handle e-mail functions.

Applicant would respectfully remind the Examiner, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim" for a disclosure to properly form the basis of a 35 U.S.C. § 102 rejection, see M.P.E.P. § 2131, citing *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q.2d 1913 (Fed. Cir. 1989). Applicant respectfully asserts that an agent adapted to compare the characteristics of email messages received for the subscriber, and to execute instructions received from the subscriber in response to the alert as set forth in claims 1 and 5 is not present in the disclosure of Pepe. Nor is the prerecording on a mail server characteristics for messages to be routed, alerting the subscriber to the receipt of one or more messages for which a characteristic match is found and receiving instructions for forwarding the stored messages from the subscriber in response to the alert as set forth in claim 9, or the

receiver adapted to receiving e-mail messages, a comparator adapted for comparing characteristics of received messages, an alert mechanism for alerting the subscriber, and save facility adapted for storing matched messages against future distribution instructions received from the subscriber in response to the alert as required by claim 13. Therefore, the 35 U.S.C. § 102 rejection of claims 1, 5, 9 and 13 should be withdrawn.

Claim 2 depends from claim 1, claim 6 depends from claim 5, claim 10 depends from claim 9 and claim 15 depends from claims 13, therefore claims 2, 6, 10 and 15 inherit all the limitations of their respective base claims. For the reasons set forth above, Pepe does not teach all the limitations of claims 1, 5, 9 and 13, therefore claims 2, 6, 10 and 15 are allowable for the reasons set forth with respect to claims 1, 5, 9 and 13.

Claim 19 requires receiving a message, comparing the message to criteria, if the message matches the criteria, then sending an alert to the subscriber, receiving a reply from the subscriber in response to the alert, the reply comprising instructions for the message, and processing the message according to the instructions. As stated, Pepe only describes instructions in response to an alert for incoming voice calls. Pepe does not describe processing a message according to instructions received in response to an alert. The Examiner has cited the same passages from Pepe as were cited with respect to claims 1, 5, 9 and 13. The Applicant would again point out to the Examiner that the referenced description describes a way for a subscriber to direct incoming phone calls based on caller id information. An incoming telephone call is not a message as required by claim 19, further an alert is sent to the subscriber for every telephone call, there is no filtering based on criteria.

As stated above, “[t]he identical invention must be shown in as complete detail as is contained in the . . . claim” for a disclosure to properly form the basis of a 35 U.S.C. § 102 rejection, see M.P.E.P. § 2131, citing *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q.2d 1913 (Fed. Cir. 1989). Pepe does not describe processing a message according to instructions received in response to an alert as required by claim 19. As Pepe does not disclose all the limitations described in claim 19, the rejection of record should be withdrawn.

Claims 20-29 depend from claim 19 and thereby inherit all of the limitations of claim 19. For the reasons set forth above the rejection of record does not meet all of the limitations

of claim 19. Therefore, the Applicant respectfully submits that claims 20-29 are allowable for at least the reasons set forth above.

III. The 35 U.S.C. § 103 Rejections

Claims 4, 8, 11, and 17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Pepe. Claims 3, 7, 12, and 18 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Pepe in view of U.S. Patent Number 6,545,589 to Fuller et al. (hereinafter "Fuller").

Claims 3 and 4 depend from base claim 1, and, therefore, inherit all the limitations of claim 1. As claim 1 is allowable for at least the reasons set forth above, claims 3 and 4 are allowable for at least the reasons set forth with respect to claim 1.

Claims 7 and 8 depend from base claim 5, and, therefore, inherit all the limitations of claim 5. As claim 5 is allowable for at least the reasons set forth above, claims 7 and 8 are allowable for at least the reasons set forth with respect to claim 5.

Claims 11 and 12 depend from base claim 9, and, therefore, inherit all the limitations of claim 9. As claim 9 is allowable for at least the reasons set forth above, claims 11 and 12 are allowable for at least the reasons set forth with respect to claim 9.

Claims 17 and 18 depend from base claim 13, and, therefore, inherit all the limitations of claim 13. As claim 13 is allowable for at least the reasons set forth above, claims 17 and 18 are allowable for at least the reasons set forth with respect to claim 13.

Claims 20-29 depend from base claim 19, and, therefore, inherit all the limitations of claim 19. As claim 19 is allowable for at least the reasons set forth above, claims 20-29 are allowable for at least the reasons set forth with respect to claim 19.

The limitations of claim 16 have again not been addressed by the Examiner in the present office action, Applicant therefore concludes that claim 16 contains allowable subject matter.

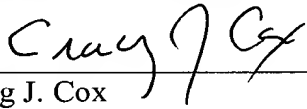
IV. Summary

In view of the above, each of the pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

As this request and amendment are timely filed within three months from the Final Office Action dated May 19, 2005, Applicant believes that there are no extension fees due. However, if a fee is due, please charge our Deposit Account No. 06-2380, under Order No. 66360/P001D1/10402620 from which the undersigned is authorized to draw.

Dated: August 18, 2005

Respectfully submitted,

By 
Craig J. Cox

Registration No.: 39,643
FULBRIGHT & JAWORSKI L.L.P.
2200 Ross Avenue, Suite 2800
Dallas, Texas 75201-2784
(214) 855-7142
(214) 855-8200 (Fax)
Attorney for Applicant